Amendments to the Figures

Please substitute the five (5) sheets of replacement drawings provided in the Appendix for the ones currently pending that relate to Figures 1A-1C, 3 and 5A.

Remarks

Status of the Claims

Claims 33-61 are currently pending in the application. Claims 1-32 and 62-212 have been withdrawn from consideration without prejudice to Applicant's ability to file one or more divisional patent applications at a later time. The Office Action of 31 October 2005 has been carefully reviewed. Applicant respectfully submits that the amendments above and accompanying detailed remarks below overcome the objections to the drawings, specification and abstract, and the rejections of the claims, as indicated in the Action.

Objections to the Drawings

Applicant thanks the Examiner for pointing out the inconsistencies and/or omissions in the figures. Appropriate corrections have been made, as now described.

(a) The drawings were objected to as failing to comply with 37 CFR §1.84(p)(4) related to duplicative use of reference characters in certain figures and text. Figures 1A, 1B, and 1C have been amended by submission of replacement sheets, and paragraph [0021] has been amended above, all to harmonize usage of reference character (16) to refer to trampolines, and character (64) to refer to the basketball stand. Further, Figure 3 has been amended by submission of replacement sheet, and paragraph [0026] has been amended above, to harmonize usage of reference character (32) to refer an inflexible surface, and character (26') to refer to horizontally disposed hydraulic pistons.

(b) The drawings were objected to as failing to comply with 37 CFR §1.84(p)(5) related to an omission of reference characters (62) from Figure 5A. Figure 5A has been amended by replacement sheet to add reference characters (62) to comport with the text of the specification.

In light of the foregoing amendments, Applicant requests reconsideration and withdrawal of these grounds for objection to the drawings.

Objections to the Specification

The specification was objected to on various grounds that have been overcome by the following amendments:

(a) Paragraphs [0003], [0004], [0007], [0010], [0011], [0016] and [0034] have been amended to capitalize the use of the term SLAMBALL and to insert a trademark ™ notice after each appearance. These amendments address the objection of paragraph 5 in the Action.

(b) The Abstract has been amended to correct the grammatical errors noted in paragraph 6 of the Action.

(c) Paragraphs [0009] and [0028] have been amended to correct the grammatical errors noted in paragraph 7 of the Action.

In light of these amendments, reconsideration and withdrawal of the objections to the specification is requested.

Claim Rejections under 35 U.S.C. § 103(a)

(a) Claims 33-39, 60 and 61 were rejected under 35 U.S.C. § 103(a), as being unpatentable over US Patent 6,682,444 to Gordon (hereinafter "Gordon") in view of US Patent 5,482,699 to Mirando, *et al.*, (Mirando). These rejections are respectfully traversed with amendments to independent claim 33 and dependent claim 60 as follow, which clarify the novelty of the present invention:

33. A ball game system, comprising:

a planar playing surface including a resilient surface adjacent one or more deformable elastic surfaces;

a hoop dimensioned to receive a ball and disposed at an elevated position proximate an end of the playing surface;

means for adjusting the elasticity of rebounds provided by the one or more deformable elastic surfaces;

means for receiving a payment; and

means for controlling the elasticity adjusting means in response to the payment received so as to restrict or enable player use of the one or more deformable elastic surfaces.

60. *The ball game system of claim 33, wherein the hoop position is adjustable from a horizontal position permitting use to a substantially vertical position restricting use of the hoop in response to the payment received.*

The instant Action asserts that Gordon teaches all the limitations of claim 33 but for a payment receiving means, including a means for controlling the elasticity adjustment means, and that Mirando's coin operated mechanism supplies the disclosure missing from Gordon.

MPEP §2141 instructs that "when applying 35 USC103, the following tenets of patent law must be adhered to:
(A) The claimed invention must be considered as a whole;
(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
(C) The references must be viewed without benefit of impermissible hindsight vision afforded by the claimed invention; and
(D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Applicant respectfully submits that the references, considered as a whole, neither teach nor suggest the invention as claimed in amended claim 33, and that any interpretation of the references as doing so results from impermissible hindsight following a reading of Applicant's specification.

More specifically, neither Gordon nor Mirando teach a *means for adjusting the elasticity of rebounds provided by the one or more deformable elastic surfaces* nor a *means for controlling the elasticity adjusting means in response to the payment received so as to restrict or enable player use of the one or more deformable elastic surfaces.* Applicant submits that not only, as recognized by the Examiner, does Gordon "not expressly disclose the particular structure for the hydraulic or pneumatic mechanism" but also that restricting or controlling access to the ball game system by reducing or eliminating the elasticity of the elastic surfaces in response to a user's payment was not even being contemplated by Gordon.

With respect to the passages of Gordon cited in the Action as supporting the Examiner's assertion, col. 6, lines 14-32 and 66-67, and col. 7, lines 1-39 teach or suggest nothing outside of an ordinary trampoline construction, and define "tuning" as adjusting the trampoline to a primary natural frequency for use, with no suggestion that the elasticity could be eliminated as a means to dynamically restrict use of the trampoline in response to a payment for use. Further, the cited passage of Gordon at column 9, lines 34-47 describes adjustment of "active suspension elements" for Gordon's resilient floor (160) rather than his elastic surface (106). Again, Gordon is devoid of any suggestion that his elastic surface should be so adjusted, and certainly not in response to a payment.

The Action asserts that in view of Mirando it would have been obvious to include a coin-operated mechanism for the ball game system of Gordon so that the playing time for each group is predetermined by the payment amount. Applicant submits that the present invention, as recited in amended claim 33, is a non-trivial and unobvious expansion beyond Mirando's coin operated mechanism (82). Restricting access to an elastic based ball game system by a mechanism that reduces or eliminates elasticity in the playing surface differs in function, way and result from the implementation of Mirando, which merely limits the number of balls delivered to a player via gate (86). (This point is also applicable to amended claim 60, which restricts access to the hoop by re-orienting the hoop to a non-usable, substantially vertical position.)

The MPEP §2141.03 instructs that in determining novelty of an invention, the level of skill of a person of ordinary skill in the art must be determined. "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), *cert. denied*, 464 US 1043 (1984). Applicant asserts that the level of ordinary skill in the art of ball games is one of relatively low sophistication, which favors Appellant's position of nonobviousness.

Thus, independent claim 33 (as amended) and dependent claim 60 are nonobvious in light of the cited art. Claims 34-39, 60 and 61 depend from independent claim 33. If an independent claim is nonobvious, claims that depend from the independent claim are also nonobvious. *In re Fine*, 837 F.2d 1071, 1071; 5 USPQ2d 1596 (Fed. Cir. 1988). In this light, Applicant respectfully requests reconsideration and withdrawal of this ground for rejection.

(b) Additionally, claims 40-59 were rejected under 35 USC §103(a) as being unpatentable over the prior art applied to claim 33 above, and further in view of US patent 5,776,018 to Simpson, *et al.* (hereinafter "Simpson"). Applicant submits that Simpson is directed to a basketball collection, passing and shot analysis system, and does not supply the disclosure missing from Gordon and Mirando above, namely a *means for adjusting the elasticity of rebounds provided by the one or more deformable elastic surfaces* nor a *means for controlling the elasticity adjusting means in response to the payment received so as to restrict or enable player use of the one or more deformable elastic surfaces.* Whereas these limitations are present in claims 40-59 through dependency from amended claim 33, these claims are similarly patentable over the cited art, without the additional novel features of claims 40-59.

In light of the foregoing, Applicant requests reconsideration and withdrawal of all grounds for claim rejections and objections to the drawings and specification. Applicant respectfully submits that the pending claims 33-61 are in a condition for allowance, and a notice

to that effect is earnestly solicited. The Examiner is invited to call Applicant's counsel at (617) 854-4000 at the time of review of this amendment, in order to have answered any remaining questions and to avoid the expense of another round of written response.

Respectfully submitted,
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